

## EXHIBIT 9

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Bank of America, N.A.

ASKELADDEN L.L.C.,  
Petitioner,

v.

VERIFY SMART CORP.,  
Patent Owner.

Case IPR2017-  
Patent No. 8,285,648

**PETITION FOR COVERED BUSINESS-  
METHOD PATENT INTER PARTES REVIEW  
OF CLAIMS 1-19 OF U.S. PATENT NO.  
8,285,648 CHALLENGING CLAIMS 1-19  
UNDER 35 U.S.C. § 321, 37 C.F.R. §  
42.3048,285,648**

Mail Stop PATENT BOARD  
Patent Trial and Appeal Board  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Pursuant to 35 U.S.C. §§311-319 and 37 C.F.R. §42, Askeladden L.L.C. (“Petitioner”) respectfully petitions for *Inter Partes* Review of Claims 1-19 of U.S. Patent No. 8,285,648 (“the ’648 Patent,” Ex.1001), which is believed to be currently assigned to Verify Smart Corp. (“Verify Smart” or “Patent Owner”). Petitioner submits the Expert Declaration of Ivan Zatkovich (Ex.1002) in support of this Petition. As demonstrated herein with the support of testimonial evidence, there is a reasonable likelihood that Petitioner will prevail in establishing that at least one of the challenged claims is unpatentable. Accordingly, institution of an IPR under 37 C.F.R. §42.108 is requested.

## I. INTRODUCTION

U.S. Patent No. 8,285,648 (the “’648 Patent”) is directed to the abstract idea of using a verification code (e.g., a password) to verify the identity of a user in a financial transaction. Specifically, The ’648 Patent discloses a method and claims a system and method for verifying a user’s identity wherein the identity of a user in a financial transaction. During an enrollment process, a user is assigned a PIN or password (“bona fide secure identifier”), which is stored in a “verifier-database” accessible to a “verifier-computer.” See (Ex.1001 at 4:24-29, 6:52- 55, Fig. 1-). When the user wishes to conduct execute a financial transaction such as a credit card purchase, the verifier-computer opens a communications link and sends an “identity verification request (IVR)” to the user, for example as an SMS text message, requesting user’s mobile device, which requests entry of the assigned PIN or password. (*Id.* at 4:34-41, 8:13-39.). In response, the user enters and sends a password (“putative secure identifier”), *id.* at 8:51-57 to the verifier-computer, which the verifier-computer compares to the previously assigned bona fide secure identifier. If they match, the financial transaction is allowed to proceed. *Id.* at 9:5-10.

U.S. Patent No.

8,285,648 Petition for Covered Business Method

*Alice Corp.* test, and are invalid under 35 U.S.C. § 101.

**B. Ground 2: Claims 1-3, 5-7, 9-12, And 19 Are Invalid Under § 102 (a) And (b) As Anticipated By Law**

Law, titled “Secure Wireless Authorization System,” was published on August 25, 2005. Thus, Law qualifies as and is therefore prior art to the ’648 Patent under 35 U.S.C. §102 (a) and (b), and is a permissible basis for this Petition pursuant to AIA § 18(a)(1)(C). The USPTO did not consider Law during the prosecution of the application leading to the ’648 Patent.

**1. Overview of Law**

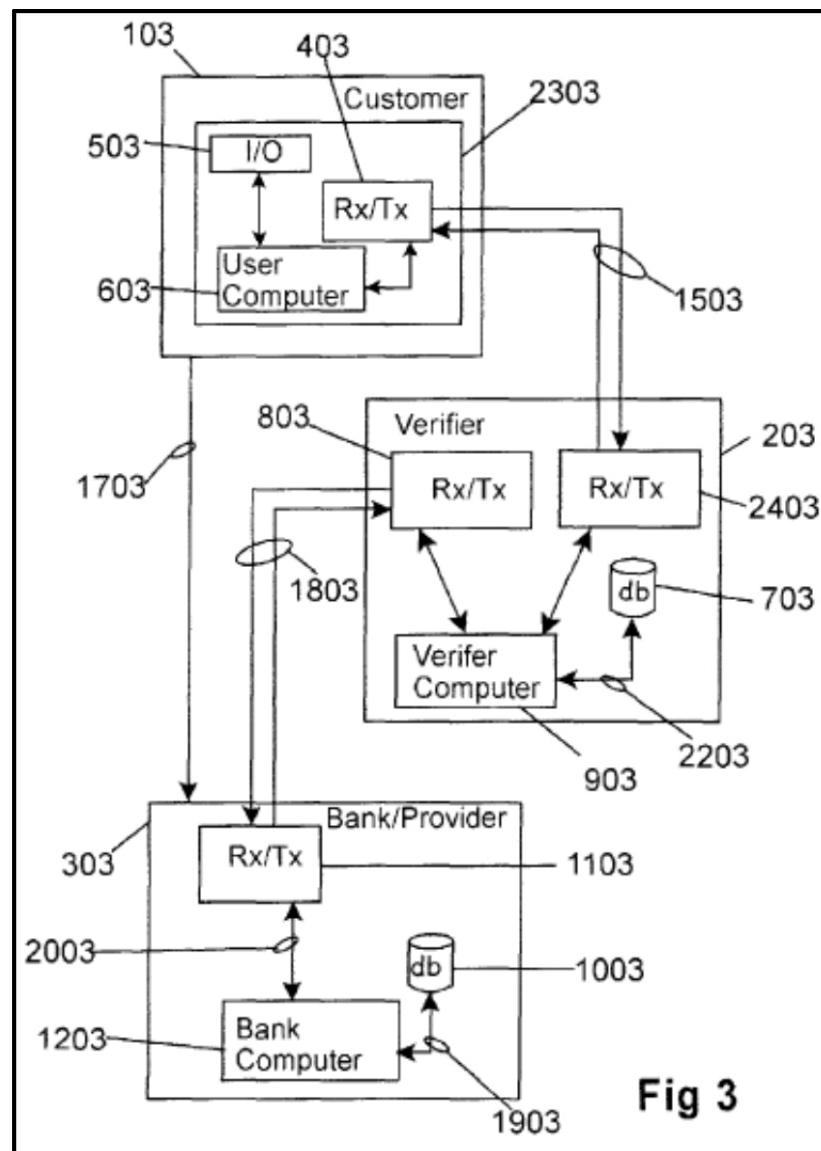
Law discloses “a secure wireless authorization system by which a user can employ a wireless device to authorize a request that is initiated by a remote third party and transmitted to the user by an authorization server.” (Ex. 1007 at 1005, Abstract.) Law describes three authorization models that can be implemented with the disclosed system: pre-authorization, real-time authorization and post-authorization. Ex. 1007 ¶(Id. at ¶42).

42. These models can operate individually, in a pair, or all in unison. Id. Of particular relevance to this Petition here is the real-time authorization model shown in Figure 3, (reproduced below), in which the identity of a user is authenticated during a financial transaction. (Id. ¶ at ¶47, Fig.

3. Figure 6 shows a variation of this real-time authorization model in which the

authorization server initiates the connection.<sup>2</sup> Id. ¶¶ 61-62, Fig. 6. 3.). Like the claimed invention of the ’648 Patent, (Ex. 1001, 9:55-57), the real-time authorization model disclosed in by Law (Fig. 3 or 6) can be used to verify the identity of a buyer in a credit card financial transaction. Ex. 1001 at 9:55-57; (Ex. 1007 ¶ 1005 at ¶21.).

U.S. Patent No.  
8,285,648 Petition for Covered Business Method



In this real-time authorization model, a user initiates a transaction with a third party such as, for example, an online merchant or a retailer with a point-of-sale device. (Ex.100<sup>75</sup>, ¶36-). The transaction is put in a “pending” state while the third-party submits an authorization request to an “authorization server.” (*Id.* ¶¶ at ¶47-).

The server then sends an authorization request to the user’s wireless device with the transaction details. (*Id.* ¶¶ at ¶¶47, 49-, 56-57). “A message similar to

U.S. Patent No.

8,285,648 Petition for Covered Business Method

'company X requests action Y for an amount Z, would you like to proceed?' would be displayed on the wireless device." (*Id.* at ¶49).

The user authorizes the transaction by entering a PIN number, which is transmitted back to the authorization server. (*Id.* ¶¶ at ¶¶49-). If the PIN provided is correct (*i.e.*, matches one previously stored for that user), the authorization server sends a response back to the third party to allow the transaction to proceed. (*Id.* ¶¶ at ¶¶50). See Fig. 6 reproduced below.

U.S. Patent No.

8,285,648 Petition for Covered Business Method

Therefore, this Petition should be granted, *Inter Partes Review* should be instituted, and Claims 1-3, 5-7, 9-12,~~19~~ should be found unpatentable and ~~19~~ of the '648 Patent are invalid under 35 U.S.C. § 102(a) and (b). cancelled by the Board.

Respectfully submitted,

/s/ Marc J. Pensabene

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Dated: January 18, 2017  
New York, New York

By: /Charles R. Macedo/  
Charles R. Macedo  
Registration No.: 32,781

U.S. Patent No.

8,285,648 Petition for Covered Business Method

**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. §§42.6(e) and 42.105, I hereby certify that on August 12, 2015, I caused this 18<sup>th</sup> day of January 2017, a true and correct copy of the following materials:

Petition for Covered Business Method Patent Review foregoing PETITION FOR INTER PARTES REVIEW OF CLAIMS 1-19 OF U.S. PATENT NO.

8,285,648 Challenging Claims 1-19 Under 35 U.S.C. § 321, 37 C.F.R., together § 42.304

- Exhibits with Petitioner's Power of Attorney, Petitioner's Exhibit List, and Exhibit Nos. 1001-1011 of Petition for Covered Business Method Patent Review of U.S. Patent No. 8,285,648

to be, was served via Priority Mail Express Mail® on the patent owner at the following attorney correspondence address of record as listed on PAIR:

Denis O'Brien for VERMETTE & CO.  
1177 West Hastings Street, Suite  
320 Vancouver, BC  
Canada V6E 2K3

I also hereby certify that on August 12, 2015, I caused a true and correct copy of the Petition for Covered Business Method Patent Review and Exhibits to be served via Express Mail on the following party listed under "Correspondence Address" on PAIR subject patent:

DAN SCAMMELL  
1729 Hampton Drive  
Coquitlam, BC, CANADA V3E 3C9

In addition, service is also made at the following "address known to the petitioner as likely to effect service" pursuant to 37 C.F.R. §42.105(a):

VERMETTE & CO.

I also hereby certify that on August 12, 2015, I caused a true and correct copy of the Petition for Covered Business Method Patent Review and Exhibits to be served via Express Mail on the following party alleged to be the owner of U.S. Patent No.

U.S. Patent No.

8,285,648 Petition for Covered Business Method

~~8,285,648 in the litigation *Verify Smart Corp. v. Bank of America, N.A.*, Case No.~~

~~2:15-cv-05348 MCA MAH~~, pending in the U.S. District Court for the District of New Jersey:

Verify Smart Corp. c/o Robert C. Harris  
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Anthony Cinotti  
President and Director  
VERIFY SMART CORP.

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~~A courtesy copy was also sent to the alleged patent owner's litigation counsel at the following address:~~

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U.S. Patent No.

8,285,648 Petition for Covered Business Method

Dated: January 18, 2017  
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